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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,120	09/16/2003	Phillip Montgomery Hudnall	71316-04	7144

7590 03/30/2005

Mark L. Davis
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Gray, TN 37615-9293

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,120

Applicant(s)HUDNALL, PHILLIP
MONTGOMERY**Examiner**

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 15-41 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

This application is up for consideration.

A. A telephone call to Mr. Mark I. Davis is made on 23 March 2005 to request an election of species and an election of an invention. Mr. Davis requests a written Office action.

B.1. Claims 15-41 are generic to a plurality of disclosed patentably distinct species comprising many possible of color developer preservatives in the art with some of them being identified on page 11, lines 15-22. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

2. Claims 20-41 are generic to a plurality of disclosed patentably distinct species comprising many possible hydrogenation solvents in the art with some of them being identified on page 10, lines 4-15. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species one or a set of solvents, even though this requirement is traversed.

3. Claims 26-41 are generic to a plurality of disclosed patentably distinct species comprising many possible species of first solvents in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

4. Claims 26-41 are generic to a plurality of disclosed patentably distinct species comprising many possible of second solvents in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

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5. Claims 20-41 are generic to a plurality of disclosed patentably distinct species comprising many possible precursor compounds in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

6. Claims 15-41 are generic to a plurality of disclosed patentably distinct species comprising many possible p-phenylenediamine free base in the art. Applicant is required under 35 U.S.C. 121 to elect a single species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

C. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 15-19, drawn to a color developing solid, classified in class 430, subclass 465.
- II. Claims 20-25, drawn to a preparing process, classified in class 430, subclass 490.
- III. Claims 26-32, drawn to another preparing process having a patentably different and distinct steps from those in Group "III" above, classified in class 430, subclass 493.
- VI. Claims 33-36, drawn to another preparing process having a patentably different and distinct steps from those in Groups "III" and "IV" above, classified in class 430, subclass 484.

- V. Claims 37-41, drawn to another preparing process having a patentably different and distinct steps from those in Groups “III”, “VI” and “V” above, classified in class 430, subclass 450.

The inventions of Groups II, III and IV are related to processes but have the patentably different and distinct processing steps and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Inventions of Group I and Groups (II, III and IV) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process of making p-phenylenediamine free base color developing developer can be used to made other an material different product such as a ready-to-use color developing solution. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status in the art and can support the separate patents as divided by applicants and have

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no evidence of the record that they are not patentably different or distinct and are the obvious variants under 35 U.S.C. 103 to one having ordinary skill in the art since no separate consideration or search is necessitated or required because a prior art being applied against one invention is sufficient against all of them, restriction for examination purposes as indicated is proper.

D. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

E. However a process claim is permitted to be rejoined with an allowable material claim provided the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *In re Ochiai*, 37 USPQ2d 1127 or *In re Brouwer*, 37 USPQ2d 1663 and MPEP 821.04. Accordingly, applicants are required to identify any process claim that contains all of the limitations the elected material claims for an examination in each of the response to an office action in order for it to be properly and timely rejoined as set forth.

F. Other issues have not been considered until a proper election is made and resolved.

H. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL.
23 March 2005

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.